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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,081	04/13/2004	Timothy Elwell	105381-0002	3160
21125 7590 07/12/2007 NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			EXAMINER CADUGAN, ERICA E	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 07/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,081

Applicant(s)

ELWELL, TIMOTHY

Examiner

Erica E. Cadugan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/3/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

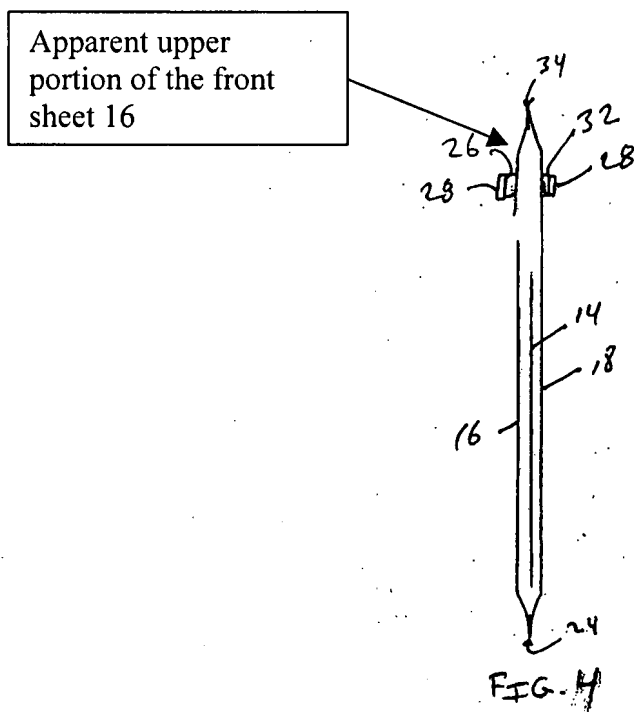
1. Applicant's election without traverse of Group I, claims 1-27 in the reply filed on December 14, 2006 is acknowledged.
2. Claims 28-33 are thus withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 14, 2006.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore:

the embodiment of claim 1 wherein the "foldable flap" is formed "extending from one of the front sheet or the back sheet beyond the other of the front or back sheets" (noting that as best understood, it appears that the opening 12 shown in the only shown embodiment is formed as a slit in the front sheet 16, noting the apparent upper portion of sheet 16 labeled below in the reproduction of Figure 4), and thus, the flap does not extend from the front sheet beyond the back sheet, nor does it extend from the back sheet beyond the front, noting that the flap is shown as **part of** the front sheet;

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the embodiment of claim 3 wherein the foldable flap extends from the back sheet “beyond the height of the front sheet” (again noting that it appears that the flap includes part of the front sheet 16, and thus does not extend “beyond the height of the front sheet” as claimed;

the embodiment wherein the “outer and inner sheets” having “different thicknesses” as set forth in claim 16;

the embodiment wherein the “front and back sheets are heat sealed at a top end of the dust jacket cover” of claim 20;

the embodiments of claim 21 wherein the opening 12 is a slit formed in the inner sheet adjacent “at least a portion of one of the opposed side ends”, or the “bottom end”;

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the embodiment of claim 22, wherein the opening “is a slit formed in the back sheet adjacent to the top end of the dust jacket cover and the foldable flap is disposed above the slit”;

as best understood, the drawings do not show that the first adhesive layer is formed “on an inner surface” of the foldable flap as set forth in claim 23;

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification does not appear to teach/provide antecedent basis for the limitations that the dust jacket 14 itself (as opposed to the dust jacket cover 10) is made of “flexible polymeric material” as set forth in claims 11 and 26, is “resistant to infrared and ultraviolet light” as in claims 12 and 27; and is a “polyolefin” as in claim 13. Additionally, the specification as originally filed does not appear to provide antecedent basis for the limitation of claim 15 that the “outer and inner sheets have substantially the same thickness”, nor the limitation of claim 16 that the “outer and inner sheets have different thicknesses”. Additionally, the specification as originally filed does not appear to provide antecedent basis for the limitations of claim 21 wherein the opening is a slit formed in the inner sheet adjacent to at least a portion of one of the opposed side ends or the bottom end, or the embodiment of claim 22, wherein the opening “is a slit formed in the back sheet adjacent to the top end of the dust jacket cover and the foldable flap is disposed above the slit”, or as best understood, that the first adhesive layer is formed “on an inner surface” of the foldable flap as set forth in claim 23.

Claim Objections

5. Claim 5, as best understood, is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

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Claim 5 depends from claim 1, and sets forth that the "inner sheet is transparent". As best understood, it appears that the "inner sheet" is the front sheet 16, and that claim 1 already sets forth that the front sheet is transparent.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5-9, 12, 14-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There are several positively recited limitations that lack sufficient antecedent bases in the claims. A few examples of this are: "the inner sheet" in claim 5; "the opening side" in claim 6; "the sealed bottom end" in claim 8; "the opposed side ends" in claim 9; "the outer sheet" in claim 14; "the inner sheet" in claim 14 (note that this terminology is also used in claims 15-16); "the inner and outer sheets" in claim 17, line 5 (note that this terminology is also used in claim 21); "the opposed side ends" in claim 19; "the top end" in claim 21; "the bottom end" in claim 21; "the top end" in claim 22; . This is not meant to be an all-inclusive list of such occurrences. Applicant is required to review the claims and correct any other such occurrences of limitations lacking sufficient antecedent basis.

The term "resistant to infrared and ultraviolet light" in claims 12 and 27 is a relative term which renders the claim indefinite. The term "resistant to infrared and ultraviolet light" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the

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invention. It is noted that it is unclear what degree of blockage of the IR and UV rays constitutes “resistant” to IR and UV light.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 5-9, 11-13, 17-20, and 26-27, any of which were rejected under 35 USC 112 above are as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2132585 (hereinafter GB ‘585).

GB ‘585 teaches a security bag/envelope that is transparent (see the abstract, lines 3-4).

The bag/envelope is formed from front and back sheets 2a, 2b that are heat sealed at opposed side edges 4 and 5 (see page 1, lines 87-91, for example, also Figure 1). Additionally, the bag/envelope is sealed at the bottom edge 3 by either a heat seal (Figure 1, page 1, lines 87-91) or by a fold (see page 2, lines 14-26). Furthermore, a foldable flap 7, having an adhesive layer 8 with a protective strip 8a removably disposed thereon (Figures 1-3 and page 1, lines 101-105, for example) is formed adjacent to an opening and extending beyond the “front” sheet 2b (see Figures 1-3).

Upon removal of the protective strip 8a, the flap 7 is folded over the opening to close the bag/envelope and seal the contents thereof inside (see at least Figures 1-3 and page 2, lines 7-13, for example).

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Regarding the intended use of the cover/envelope/bag as being used to cover a “dust jacket”, it is noted that dust jackets, as do books, come in an infinitely wide range of sizes, and that the device taught by GB ‘585 is considered to be inherently capable of functioning to protect a dust jacket, simply by placing the dust jacket inside, removing the protective strip 8a to expose the adhesive 8, and folding the flap 7 to seal the device.

Re claims 11-13 and 26-27, as best understood from the present specification (paragraphs 022 and 023), it appears that Applicant intended for the claimed polymeric material to refer to the material of the protective dust jacket cover (10) and not to the material of the dust jacket (14) itself. Thus, as best understood re claims 11, 26, and 13, it is noted that GB ‘585 teaches that the material of the cover is a thermoplastic film such as polyethylene (page 1, lines 83-84, for example), and it is noted that polyethylene is a polyolefin. Furthermore, as broadly claimed re claims 12 and 27, the polyethylene is considered inherently to be at least in some small way to be “resistant” to IR and UV light.

10. Claims 1-13, 17-27, any of which were rejected under 35 USC 112 above are as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 6,270,256 to Todman.

Todman teaches an envelope-like security bag 6 formed of a transparent flexible thermoplastic sheet material such as polyethylene or polypropylene (see at least col. 2, lines 41-54), for example, wherein front and back “sheets” 3, 4 of a piece of sheet material are separated by a fold at the bottom and are heat welded/sealed to one another in a zone 5 that extends parallel with and close to each of the longitudinal and lateral edges of the “cover” 6 (see Figures 1, 3-5, and col. 2, lines 41-54). A slit 8 in the “sheet” 3 provides an opening into a receiving space

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between the sheets 3, 4 (see Figures 1-5 and col. 2, lines 55-58, for example). A foldable flap 7 extends beyond the sheet 3 (see Figures 1-5). An adhesive layer 13 is covered by a protective strip 14. When the strip 14 is removed, the flap 7 is folded so as to cover the slit 8 and completely seal the bag 6 (see at least Figures 1-5 and col. 3, lines 1-30, for example).

Regarding the intended use of the cover/envelope/bag as being used to cover a “dust jacket”, it is noted that dust jackets, as do books, come in an infinitely wide range of sizes, and that the device taught by Todman is considered to be inherently capable of functioning to protect a dust jacket, simply by placing the dust jacket inside, removing the protective strip 14 to expose the adhesive 13, and folding the flap 7 to seal the device as described in at least col. 3, lines 15-30, for example.

Re claim 4, it is noted that the device also includes a second adhesive layer 10 covered by a “protective strip” in the form of tape 9, which tape 9 is considered to be removably disposed, as broadly claimed, in that it is able to be removed from the device, **at least** by cutting the end of the bag off, for example. Further note that either sheet 3 or 4 can be considered the claimed “front” sheet, and that, firstly, thus the second adhesive layer 10 is located on the “front” sheet 4, and that alternatively, when the flap 7 is in the closed position, the adhesive layer 10 is located on an “outer” surface of the sheet 3.

Re claim 6, note that slit 8 is located adjacent the top end of the device as shown in Figures 1 and 3-5.

Re claims 10 and 25, see col. 3, lines 24-30, lines 46-66, and Figures 3-4, noting that Todman explicitly teaches that the bag is sealed “completely and there is no access opening

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whatsoever to the interior of the bag 6", and thus, the device is considered to be "impermeable to air, water, moisture, and pests" when the flap is closed and adhered.

Re claims 11-13 and 26-27, as best understood from the present specification (paragraphs 022 and 023), it appears that Applicant intended for the claimed polymeric material to refer to the material of the protective dust jacket cover (10) and not to the material of the dust jacket (14) itself. Thus, as best understood re claims 11, 26, and 13, it is noted that Todman teaches that the material of the cover is a thermoplastic film such as polypropylene or polyethylene (col. 2, lines 41-44), and it is noted that both polypropylene and polyethylene are polyolefins. Furthermore, as broadly claimed re claims 12 and 27, the polypropylene and polyethylene are considered inherently to be at least in some small way to be "resistant" to IR and UV light.

It is noted that at least since the present disclosure teaches that polypropylene is used, the polypropylene taught by Todman is inherently considered to possess the properties of being resistant to infrared and ultraviolet light as claimed.

Re claim 20, firstly, it is noted that, as broadly claimed, any side of the bag device 6 shown in the figures can be considered to be the claimed "top end", noting that the bag device 6 will function to hold its contents in any orientation and that the claims do not provide any further frame of reference that would distinguish the top end from any other end. That being said, it is noted that the front and back sheets 3, 4 are heat sealed at 5 along a top end thereof wherein the top end is as viewed in Figures 1 and 3-5 (see area 5 of Figure 2 as well as col. 2, lines 49-54 which teaches that area 5 includes an area parallel with and close to each of the longitudinal and lateral edges of the bag 6).

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Re claims 21 and 22, it is noted that either of the sheets 3, 4 can be considered the “front”, that either of the sheets 4, 3, respectively can be considered the “back” as broadly claimed. Referring to the other designation set forth in the claims, it is also noted that either of the sheets 3, 4 can be considered the “inner” sheet, and that the either of the sheets 4, 3, respectively, can be considered the “outer” sheet. That being said, slit 8 is considered to be located as set forth in claims 21 and 22. Re claim 22, note that flap 7 is located “above” (above is as shown in Figures 1 and 3-5, for example) the slit 8.

Re claim 23, note that “first adhesive layer” 10 is located on an “inner” surface of the flap 7, i.e., it’s on the flap at an “inner” location closer to the flap, and re claim 24, note that second adhesive layer 13 is located on an “outer surface” of the flap 7 in that it is on the flap in a location that is further “out” than the inner location of the adhesive 10. Furthermore, note that the “second adhesive layer” 13 includes a protective strip 14 removably disposed thereon (Figures 1-5, col. 3, lines 1-30, for example).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 14-16, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2132585 (GB ‘585) as applied to at least claim 1 above.

GB ‘585 teaches all aspects of the presently-claimed invention as set forth above, but is silent as to the value or range of values of the thicknesses of the sheets 2a, 2b, and thus does not

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explicitly teach that the thicknesses of the sheets are “in the range of about 1 to about 1.4 mils” as set forth in claim 14.

Re claim 15, GB ‘585 does teach that the front and back sheets 2a, 2b can be formed from the same piece of material to create a fold at the bottom 3 of the “cover” (see page 2, lines 14-26, for example), and thus, since the front and back sheets would thus be from the same piece of material, they are considered to have “substantially the same thickness” as set forth in claim 15.

Re claim 16, GB ‘585 does teach an embodiment wherein the front and back sheets 2a, 2b are formed of separate pieces of material that are heat sealed at the bottom 3 and sides 4, 5 (page 1, lines 83-91), but is silent as to whether or not the two pieces of material have different thicknesses as set forth in claim 16.

Therefore, re claim 14, particularly absent any criticality alleged, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the range of thicknesses any thin range as was desired or expedient to an end user, including within the claimed range of about 1 to about 1.4 mils, particularly since it appears that GB ‘585’s envelope would function as intended with thicknesses in that range or within the undisclosed range of GB ‘585’s device (noting that they are both configured as an envelope), since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

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Similarly, re claim 16, Applicant has not alleged any criticality to the thickness of the two sheets being different (indeed noting that present claim 15 sets forth that the two sheets have substantially the **same** thickness).

Therefore, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to have made the two sheets in the embodiment of page 1, lines 83-91 be of different thicknesses because Applicant has not alleged any criticality to such a feature, nor indicated that such a feature provides an advantage, is used for a particular purpose, or solves a stated problem, and because it would be within the ordinary skill in the art to make the thicknesses of the two sheets whatever value was desired or expedient to an end user, including thicknesses that differed at least slightly, noting also that both GB '585's device as well as the device of the present invention would work equally well with sheets of the same thickness or with sheets of at least slightly different thicknesses, i.e., the ability of the "covers" to seal a dust jacket or other sheet within would be unaffected by making the two thicknesses differ slightly or by making the two thicknesses the same.

13. Claims 14-15, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,270,256 to Todman as applied to at least claim 1 above.

Todman teaches all aspects of the presently-claimed invention as set forth above.

Additionally, re claim 15, Todman does teach that the front and back sheets 3, 4 are formed from the same piece of material to create a fold at the bottom of the "cover" (see col. 2, lines 41-54), and thus, since the front and back sheets would thus be from the same piece of material, they are considered to have "substantially the same thickness" as set forth in claim 15.

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However, Todman is silent as to the value or range of values of the thicknesses of the sheets 3, 4, and thus does not explicitly teach that the thicknesses of the sheets are “in the range of about 1 to about 1.4 mils” as set forth in claim 14.

However, re claim 14, particularly absent any criticality alleged, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the range of thicknesses any thin range as was desired or expedient to an end user, including within the claimed range of about 1 to about 1.4 mils, particularly since it appears that Todman’s envelope/bag/cover would function as intended with thicknesses in that range or within the undisclosed range of Todman’s device (noting that they are both configured as an envelope/bag), since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Conclusion

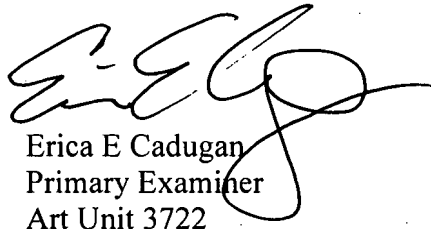
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's attention is especially directed to U.S. Pat. No. 5,429,238 to Fritz which teaches a protective transparent “dust jacket cover” 32 that is sealed on three sides, and that has a flap 40 that can be sealed or closed by any standard means (see col. 4, lines 28-49, for example).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on M-F, 6:30 a.m. to 4:00 p.m., alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Erica E Cadugan
Primary Examiner
Art Unit 3722

eec
July 5, 2007